

(e) releasing the unbound partial bundles from the at least one gripping element; and

(f) placing the unbound partial bundles in a first collection trough of a collection device; and

(g) repeating steps (a) to (f) for the required number of unbound partial bundles.

5. (Twice Amended) A method for manufacturing fiber bundles comprising:
transporting a fiber bundle using at least one feed element;
cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length;
releasing the unbound partial bundles from the at least one feed element;
gripping the unbound partial bundles using at least one gripping element;
releasing the unbound partial bundles from the at least one gripping element;
placing the unbound partial bundles in a first collection trough of a collection device; and
rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.

REMARKS

I. Introduction

Claims 1 and 5 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all copies of the certified copies of the priority documents have been received.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references, and for advising Applicants that the reference EP 0473064 was previously considered.

II. Response to Proposed Examiner's Amendment

The Office Action contends that the Applicants' previous response to the Examiner's objection to the incorporation by reference of reference EP 0 411 572 may be deemed non-responsive under 37 C.F.R. §1.121. In order to expedite the prosecution process, Applicant hereby agrees to the Examiner's proposed amendment to the specification. For the purposes of clarity, the proposed amendment to the specification is repeated herein.

III. Objection to Claim 5

Claim 5 was objected to on the basis of certain informalities. Specifically, the Examiner deems that, in claim 5, the phrase "the partial bundles" should recite --the unbound partial bundles-- in order to be consistent with claim 1. Applicant has amended claim 5 as requested by the Examiner. No new matter has been added. It is respectfully submitted that the objection to the Specification has been obviated, and withdrawal of this objection is therefore respectfully requested.

IV. Rejection of Claim 1 Under 35 U.S.C. § 102(b)

Claim 1 was rejected under 35 U.S.C. 102(b) as anticipated by U.S.

Patent No. 1,965,464 ("Koehler"). Applicants respectfully submit that Koehler does not anticipate claim 1 as amended for the following reasons.

Claim 1 as amended relates to a method for manufacturing a fiber bundle having a length from a required number of unbound partial bundles having the same lengths. Claim 1 recites that the method comprises the steps of transporting a fiber bundle strand using at least one feed element and cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length. Claim 1 also recites that the method includes the steps of releasing the unbound partial bundles from the at least one feed element and gripping the unbound partial bundles using at least one gripping element. In addition, claim 1 recites that the method includes the steps of releasing the unbound partial bundles from the at least one gripping element and placing the unbound partial bundles in a first collection trough of a collection device. These steps are repeated for the required number of unbound partial bundles.

Koehler purports to describe a machine for making tassels. Col. 1, lines 1-2. More specifically, Koehler states that "the machine makes tassels of the type in which short sections of threads or cords ... are folded to form an eye and bound together adjacent to the eye by means of a wire ring or staple." Col. 1, lines 2-6.

It is respectfully submitted that Koehler fails to disclose, or even suggest, manufacturing a fiber bundle having a length by placing a number of unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle is obtained, as recited in amended claim 1. In contrast, Koehler describes a process whereby threads or cords are folded to form an eye and are bound together adjacent to the eye by means of a wire ring. More specifically, in Koehler, threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, the ends of the threads or cords are cut by knives 74 and 75. Page 2, lines 93-96. This is in direct contravention with claim 1, which recite the manufacturing of a fiber bundle strand having a length by placing a number of unbound partial bundles *having the same lengths in a collection trough until a required thickness of the fiber bundle strand is obtained.*

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Koehler does not disclose, or even suggest, manufacturing a fiber bundle having a length by placing a number of unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle strand is obtained, as recited in amended claim 1.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Koehler does not

anticipate claim 1.

V. Allowable Subject Matter

Applicants note with appreciation the indication of allowable subject matter contained in claim 5. In this regard, the Examiner will note that claim 5 has been amended herein to overcome the Examiner's objection and to include all of the limitations of its base claim, i.e., claim 1. It is therefore respectfully submitted that claim 5 as amended herein is in condition for immediate allowance.

VI. Conclusion

Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"


It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: *September 10, 2002*

By:


Thomas C. Hughes
Reg. No. 42,674

One Broadway
New York, New York 10004
(212) 425-7200

Version with Markings to Show Changes Made

IN THE SPECIFICATION:

The paragraph beginning at page 1, line 20 has been amended as follows:

European Patent Application No. EP 0 411 572[, hereby incorporated by reference herein,] describes an apparatus for the manufacture of fiber bundles with two cylinders disposed in parallel, of which the one serves as the cutting apparatus and the other carries on its surface the fiber bundle strand coming out of the spinning machine. The cylinder designed as a cutting apparatus possesses blades extending in a radial direction by means of which the separation of the fiber strand is performed in the region between the two cylinders in portions of a desired length. The partial bundles cut in this way are removed from the blades or from the cylinder supporting the blades by means of discharge elements disposed between two blades and can be caught in a suitable collection device. The discharge elements can be moved in the radial direction of the cylinder relative to the blades and cause the blades to protrude radially in the cutting position in the region between the two cylinders and effect the desired cut of the fiber bundle strand. In regions at a distance to the cutting position, the blades are accepted in each case between two discharge elements. Disadvantages of such an apparatus are that it has a relatively complex design and that the change in the length of the partial bundles requires the cylinder supporting the blades to be changed.

IN THE CLAIMS:

Claims claims 1 and 5 have been amended without prejudice as follows:

1. (Three Times Amended) A method for manufacturing a fiber [bundles] bundle having a length from a required number of unbound partial bundles having the same lengths, the method comprising:

- (a) transporting a fiber bundle strand using at least one [fuel] feed element;
- (b) cutting the fiber bundle strand into unbound partial bundles, the unbound

Version with Markings to Show Changes Made

partial bundles having [a] said length;

(c) releasing the unbound partial bundles from the at least one feed element;

(d) gripping the unbound partial bundles using at least one gripping element;

(e) releasing the unbound partial bundles from the at least one gripping element; [and]

(f) placing the unbound partial bundles in a first collection [through] trough of a collection device; and

(g) repeating steps (a) to (f) for the required number of unbound partial bundles.

5. (Twice Amended) [The method as recited in claim 1, further comprising:] A method for manufacturing fiber bundles comprising:

transporting a fiber bundle using at least one feed element;

cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length;

releasing the unbound partial bundles from the at least one feed element;

gripping the unbound partial bundles using at least one gripping element;

releasing the unbound partial bundles from the at least one gripping element;

placing the unbound partial bundles in a first collection trough of a collection device; and

rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.